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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,667

04/09/2004

Jagadish C. Sircar

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05/23/2006

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EXAMINER

Stockton, Laura Lynne

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,667

Applicant(s)

SIRCAR ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 5-25 and 27-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/04, 10/25/04 & 3/29/2006</u> | 6) <input type="checkbox"/> Other: _____ |

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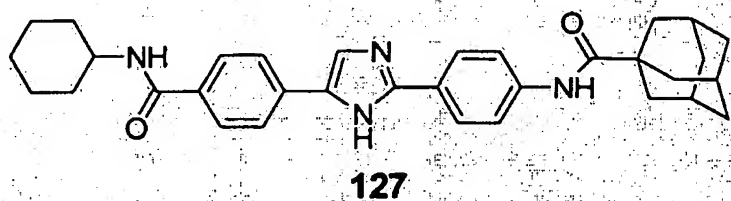
DETAILED ACTION

Claims 1-32 are pending in the application.

Election/Restrictions

Applicants' election without traverse of Group I, and the species of Compound 127 on page 70, paragraph [0248], of the instant specification (reproduced below), in the reply filed on March 6, 2006 is acknowledged.

N-Cyclohexyl-4-(2-(4-(1-adamantanamido)phenyl)-1H-imidazol-5-yl)benzamide (127)



The requirement is still deemed proper and is therefore made FINAL.

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Claims 5-25 and 27-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made **without** traverse in the reply filed on March 6, 2006.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statements filed on August 20, 2004, October 25, 2004 and March 29, 2006.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, "said substituents" lacks antecedent basis within claim 1 (page 3, line 13). Claim 4 is indefinite since claim 4 as currently amended is directed to compounds, not compositions, and therefore, the compound having an additional ingredient makes the claim unclear. In claim 26, the phrase "General 1-4, preferred substituents for R₁ and R₂ are selected from" should be deleted for the sake of clarity. In claim 26, an "and" is needed before substituent 19 and a period is needed at the end of the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3 and 26 are rejected under 35

U.S.C. 102(b) as being anticipated by:

- a) Tanaka et al. {JP 06-263993} - see Compound 6 on page 8 (or column 13) of the Japanese patent or the top of page 9 of the provided English translation of the Japanese patent;
- b) Masukawa et al. {U.S. Pat. 5,017,467} - see Example 31 in columns 11-12 and also, the compound of CA Registry No. 121216-46-4 in CA 111:31259 (1989); or
- c) Manecke et al. {Makromolekulare Chemie (1975), 176(12), pages 3551-3563} - see, for example, compounds 1b, 1c, 2b, 2c, etc. on page 3552.

Each of the above cited prior art discloses at least one compound that is embraced by the instant claimed invention. Therefore, each of the above cited prior art references anticipate the instant claimed invention.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masukawa et al. {U.S. Pat. 5,017,467} and Ninomiya et al. {EP 353,606}, each taken alone.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim imidazole compounds. Masukawa et al. (Formula I in column 2; and Example 31 in columns 11-12) and Ninomiya et al. (Formula I on pages 2-3; and Compound 7 on page 5) each teach imidazole compounds that are either structurally the same as (see above 102

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rejection) or structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP

§2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g. a cyan coupler).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at

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the instant claimed products with the expectation of obtaining additional beneficial products which would be useful as, for example, a cyan coupler. The instant claimed invention would have been suggested and therefore, obvious to one skilled in the art. A strong case of *prima facie* obviousness has been established.

Allowable Subject Matter

The elected species of Compound 127 is allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

May 17, 2006